

### REMARKS

This communication responds to the Office Action mailed on February 8, 2006. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-2, 4-5, 7-16, and 18-27 are now pending in this Application.

#### §103 Rejection of the Claims

Claims 13-14 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich et al. (U.S. 6,542,812; hereinafter "Obradovich") in view of Jones (U.S. 6,411,891; hereinafter "Jones"). Claims 1-2, 4-5, 7-12, 16, 20-22, and 24-26 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila et al. (U.S. 6,549,625; hereinafter "Rautila") and Jones. Claim 15 was rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Jones and further in view of Rautila. Claims 18-19, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila and Jones, and further in view of Masaki (EP 0883270 A1; hereinafter "Masaki"). First, the Applicant does not admit that Obradovich, Rautila, Jones, or Masaki are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on Appellant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion; *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because: (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

***Combining References Does Not Teach All Limitations:*** First, with respect to independent claims 1, 13, 16, 20, and 25, no combination suggested in the Office Action will render all of the claim limitations. As admitted by the Office, Obradovich does not disclose a mobile element having “a comparator module ... to compare the first and second service preferences” as part of the mobile element (claims 1 and 13), or downloading an application “when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element” (claim 16), or “the application is downloaded to the mobile element upon the mobile element determining that the first service preference is related to the second service preference” (claims 20, 25) as claimed by the Applicant.

Jones teaches the use of a personal computer 29 with proprietary software 223 to determine when a vehicle is approaching a specified location after receiving a message to that effect. See Jones, Col. 23, lines 44-53. User video display and audio playback preferences

associated with receiving approach messages determine which of several display and playback options will be activated to inform the user of the vehicle's imminent arrival (e.g., map display and audio mileage countdown). *See* Jones, Col. 23, line 54 – Col. 24, line 9.

It is respectfully noted that Jones teaches that the mobile unit does not include any type of comparison for user preferences – comparisons are conducted at a user's computer that monitors mobile unit position. Thus, the term “compared” as used by Jones denotes that, after a mobile unit (e.g., vehicle) approach message is received by a monitoring personal computer, user preferences included in the personal computer are compared (using the proprietary software in the personal computer – not in the mobile unit) against myriad display and playback options, reducing them to some useful number. *See Id.*

In addition, it is respectfully noted that the result of the comparison has no effect on whether or not an application is downloaded. First, because no application is downloaded to the personal computer in Jones. And second, it is only *after* a message is received that Jones' user preferences are noted by the software, and not before. That is, the comparison effected by the personal computer in Jones does nothing to affect what is received. Thus, Jones does not teach the presence of a comparator module as claimed by the Applicant. Neither do Rautila or Masaki.

Rautila is similar to Jones, in that it relies on the user, rather than the mobile element, to determine which preferences will be selected. *See* Rautila, Col. 9, lines 34-43. Masaki does not match user preferences at all. Therefore, since no combination of the references provides all of the claimed elements, independent claims 1, 13, 16, 20, and 25 are nonobvious. This conclusion applies with even greater force respecting dependent claims 2, 4-5, 7-12, 14-15, 18-19, 21-24, and 26-27 since any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03.

***No Motivation to Combine References:*** The Office asserts that it would be obvious to “modify Obradovich's system to provide ... [a] comparator module ... to compare the first and second service preferences as this arrangement would facilitate to determine user preferences for further processing as taught by Jones, thus facilitating to implement user preferences.” However, this overlooks the fact that Jones does not teach a mobile unit comprising a comparator module. Rather, in Jones, comparisons are conducted outside of the mobile unit. Thus, there is no motivation to add such comparisons to Obradovich, because comparisons would continue occur

outside of the mobile unit, while Obradovich maintains service preferences *inside* the mobile unit.

The Office asserts that it would be obvious to combine Obradovich with Rautila because “this arrangement would provide ... application programs for the user to obtain information from servers ...”. And Jones would be used to provide “a comparator module ...”. However, these assertions are incorrect. Obradovich operates by sending user location GPS data to the server in order to provide the user with a useful route map. *See* Obradovich, Col. 8, lines 30-45. Rautila teaches away from using such data, since “not all mobile terminals will have GPS functionality” and “the position transceiver overcomes the location problem of the prior art by indicating and transmitting its own very exact predefined position.” Rautila, Col. 1, lines 39-47 and Col. 2, lines 24-27. Using the position position transceiver location of Rautila would not provide a useful route map to the user of Obradovich. Thus, there is no motivation to combine Obradovich with Rautila, as such would render the apparatus of Obradovich inoperative.

The addition of Jones does nothing to overcome the fact that Rautila teaches away from combination with Obradovich, and further, Jones does not account for the limitation of downloading an application into the *mobile unit* memory based on the comparison of preferences, as claimed by the Applicant in independent claims 1, 16, 20, and 25. Jones also teaches away from comparisons conducted inside the mobile unit, and therefore, provides no motivation for combination with Obradovich. Nothing taught by Masaki overcomes the fact that both Rautila and Jones teach away from the suggested combinations.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Thus, it is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. *See* MPEP § 2141.02. Since Rautila and Jones both teach away from the claimed combination, there is no motivation to combine the references. Further, the use of unsupported assertions in the Office Action does not satisfy the explicit

requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is again respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). To-date, no such affidavit has been provided.

***No Reasonable Expectation of Success:*** Modifying Obradovich to include the personal computer comparisons of Jones will not provide a mobile element having a comparator module to compare first and second service preferences. Modifying Obradovich to implement the application download capability of Rautila will not provide a mobile element capable of determining the existence of related preferences. Neither will combining Obradovich and Masaki.

Combinations of Obradovich and Jones provide no reasonable expectation of obtaining comparisons within the mobile element. Combinations using Obradovich and Rautila provide no reasonable expectation of determining the location of the mobile element, since Rautila disclaims this process, and one of ordinary skill in the art would not be led to make a combination which leads to an inoperative result.

Therefore, since there is no evidence in the record to support the disclosure by any combination of Obradovich, Jones, Rautila, or Masaki of a mobile element that compares preferences, and can download applications based on the comparison, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 13, 16, and 20, and 25, or any of the claims that depend from them. It is therefore respectfully requested that the rejection of claims 1-2, 4-5, 7-16, and 18-27 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

**CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney Mark Muller at 210-308-5677, or the undersigned (at 612-349-9592) to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date April 5, 2006

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of April 2006.

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